REMARKS

By this Amendment, Applicants amend claims 1, 7, 15, 16, and 19 to more appropriate define the present invention, add new claim 21, and cancel claim 8 without prejudice or disclaimer of the subject matter thereof. Claims 1-4, 7, and 9-21 are pending in this application.

In the Office Action,[1] the Examiner rejected claims 1-4 and 7-20 under 35 U.S.C. § 103(a) as unpatentable over Saylor et al. (U.S. Patent No. 5,487,139) in view of Tamano et al. (U.S. Patent No. 6,032,157). Applicants respectfully traverse the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. *See* M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Amended claim 1 recites a method for manipulating a map using a data processing system including, among other things, "making a first annotation on a first region of the first map expressed by first map coordinates; converting the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map; converting the geographic coordinates to corresponding second map coordinates using a georeferencing function of the second map" and "determining a geographic region on the second map corresponding to the first region using the second map coordinates." Saylor and Tamano, whether taken alone or in combination, do not disclose or suggest at least these features.

By contrast, the Saylor system uses a vector database to create a vector map that is aligned with a raster map produced from an existing hand-drawn map. In particular, in the Saylor system, an existing cartographic drawing must be scanned to create the raster map. See col. 4, lines 51-53. A vector map is generated by receiving vector information corresponding to the raster map from a vector background database. See col. 5, lines 15-20. The raster map and the vector map are then aligned. See col. 5, lines 29-31. Once the maps are aligned, the system retrieves X, Y coordinate information for a power service interruption location, and displays that location so as to appear overlapped on the raster map. See col. 7, lines 40-52. Saylor does not teach converting the X, Y coordinates into other coordinates, and certiantly does not teach converting the X, Y coordinates into the claimed "geographic coordinates" using a georeferencing function. Saylor, therefore, fails to disclose or suggest at least "converting the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map; converting the geographic coordinates to

corresponding second map coordinates using a georeferencing function of the second map" and "determining a geographic region on the second map corresponding to the first region using the second map coordinates," as recited in claim 1.

Tamano does not cure the above-noted deficiencies of Saylor. The Tamano system allows a user to link two images, such as maps, by choosing a correspondence between objects on the images. The link enables the user to retrieve previously stored attribute information about the corresponding objects. See col. 2, lines 40-52. To link two images, the user views the images and inputs the correspondence "by selecting an object in the second image information." See col. 2, lines 40-52. Linking two images as disclosed by Tamano, however, does not disclose or suggest at least "converting the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map; converting the geographic coordinates to corresponding second map coordinates using a georeferencing function of the second map" and "determining a geographic region on the second map corresponding to the first region using the second map coordinates," as recited in claim 1. Accordingly, for at least the above reasons, Saylor and Tamano, whether taken alone or in combination, do not teach or suggest each and every element of claim 1. Applicants therefore respectfully request the Examiner to allow claim 1.

Independent claims 15 and 19 recite similar limitations as claim 1. Thus, for at least the reasons as discussed above, Saylor and Tamano, taken alone or in combination, also fail to disclose or suggest claims 15 and 19. Accordingly, Applicants respectfully request the Examiner to allow claims 15 and 19 as well.

Claims 2-4, 7, and 9-14 depend from claim 1. Claims 16-18 depend from claim 15, and claim 20 depends from claim 19. Because <u>Saylor</u> and <u>Tamano</u>, taken alone or in combination, fail to disclose or suggest every element of independent claims 1, 15, and 19, these references also fail to disclose or suggest every element of the claims that depend therefrom. Accordingly, Applicants also respectfully request the Examiner to also allow claims 2-4, 7, 9-14, 16-18, and 20.

Since Applicants have canceled claim 8, the rejection with regard to the claim is moot.

New claim 21, which depends from claim 1, is also allowable at least due to its dependence.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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